



#13/Brief
S.E.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

9/3/04

In re the PATENT application of)

Kelly GRAVELLE)

Group Art Unit: 3625)

Application No.: 09/864,443)

Examiner: Mark A. Fadok)

Filing Date: May 25, 2001)

Atty. Dkt.: 114944-00209)

For: AVI for Expedited Mobile Ordering)
And Fulfillment)

BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

AUG 27 2004

GROUP 3600

Sir:

The present Brief on Appeal is submitted further to the Notice of Appeal filed June 24,
2004.

08/25/2004 HVUDNG1 00000069 09864443

01 FC:1402

330.00 0P

I. Real Party in Interest

The real party in interest is the assignee, TC (Bermuda) License, Ltd., of Hamilton, Bermuda. In addition, Harris Trust and Savings Bank of Chicago, Illinois, holds a security interest in the application.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 1-31 have been presented for examination. All of those claims are pending, stand finally rejected, and form the subject matter of the present appeal.

IV. Status of Amendments

No Amendment after Final Rejection has been filed in the present application.

V. Summary of the Invention

The present invention is directed to an ordering method comprising: placing an order for an item by specifying the item and a location for picking up the item, and by providing an identification (page 6, lines 17-20; page 7, lines 12-18; Fig. 1, cellular telephone 120 and operator 104); relaying the order to a validating processor (page 7, lines 19 and 20; Fig. 1, local database 106 and Internet connection (not numbered) thereto); identifying a wireless tag identification number corresponding to the identification provided (page 8, lines 5-8; Fig. 1, databases 106 and 112 and the interaction therebetween); authorizing payment of the order from an account associated with the wireless tag (page 8, lines 8-15; Fig. 1, database 112, payment processor 114, and credit cards 116); and reading the tag identification number from the wireless tag when the tag is located in a vicinity of the pick up location (page 8, lines 16-20; Fig. 1, transponder 102 and reader 118).

The invention is further directed to ordering system comprising: means for placing an order for an item, the order including the item, a location for picking up the item, and an identification (page 6, lines 17-20; page 7, lines 12-18; Fig. 1, cellular telephone 120 and operator 104); a communication channel for relaying the order to a validating processor (page 7, lines 19 and 20; Fig. 1, Internet connection (not numbered) to a local database 106); means for identifying a wireless tag identification number corresponding to the identification provided (page 8, lines 5-8; Fig. 1, databases 106 and 112); means for authorizing payment of the order from an account associated with the wireless tag (page 8, lines 8-15; Fig. 1, database 112 and payment processor 114); and means for reading the tag identification number from the wireless tag when the tag is located in a vicinity of the pick up location (page 8, lines 16-20; Fig. 1, reader 118).

VI. Issue

Whether claims 1-31 stand correctly rejected under 35 U.S.C. § 103(a) over *Hall et al* in view of *Kuykendall*.

VII. Grouping of Claims

The claims fall into the following groups. Arguments for separate patentability of the groups will be presented below.

- A. Claims 1-5, 8-15, 17-20, and 23-30
- B. Claims 6 and 21
- C. Claims 7 and 22
- D. Claims 16 and 31

VIII. Argument

A. General Considerations and Claims 1-5, 8-15, 17-20, and 23-30

The Final Rejection dated December 24, 2003, has been carefully considered. In response thereto, the Appellant respectfully appeals from the rejection of claims 1-31 under 35 U.S.C. § 103(a) and submits that the present claimed invention would not have been obvious over the combination of references proposed in the Final Rejection for two reasons. First, it would not have been obvious to a person having ordinary skill in the art to combine the references as proposed in the Final Rejection. Second, such a combination, even if made, would not have resulted in the subject matter of the present claimed invention.

Before the specifics of the claims are discussed relative to the applied prior art, the Appellant wishes to note the following principles of law, which the Appellant wishes to apply to the discussion of each particular claim rejection.

First, with regard to a rejection under 35 U.S.C. § 103(a) over a combination of references, the mere fact that every element of the claimed invention can be found in the prior art does not suffice to show that the combination would have been obvious. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Such a ground of rejection would constitute impermissible hindsight. *Id.* Also, the mere level of skill in the art does not amount to a teaching to combine. *Id.*, 47 U.S.P.Q.2d at 1458. Instead,

the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Id. The permissible sources for motivation are "the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *Id.*

Second, the Office is not at liberty to pick and choose which teachings it will apply from each reference. Instead, it is legally bound to consider "disclosures in the references that diverge

from and teach away from the invention at hand." *W. L. Gore & Associates, Inc., v. Garlock, Inc.*, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983).

With those legal principles in mind, the Appellant will now discuss the specifics of the rejection.

The present claimed invention permits a combination of advance ordering with payment by a wireless tag. To achieve such a combination, the invention works as follows. A customer places an order for an item by specifying the item and a location for picking up the item, and by providing an identification (e.g., calling ahead to a fast-food restaurant and identifying oneself by telephone number or PIN). The order is relayed to a validating processor. A wireless tag identification number is identified corresponding to the identification provided (e.g., the tag number is looked up by using the telephone number or PIN). Payment of the order is authorized from an account associated with the wireless tag. When the tag is located in the vicinity of the pick up location (e.g., the customer's car pulls into the drive-through lane of the fast-food restaurant), the tag identification number is read from the wireless tag. In that way, the customer's car can be associated with the order placed in advance.

The present claimed invention is more than simply a way to pay for one's order with a wireless tag and in fact offers advantages such as those noted at the bottom of page 10 of the originally filed specification. Using AVI to facilitate a cashless transaction in a drive thru lane does not solve the problem of long lines in a drive-through. For example, the mere use of AVI by itself does nothing to speed up the lengthiest part of the process, which is the cooking time. By permitting advance ordering, the above process allows considerably faster service. It also allows for higher quality food, as it provides the time to cook fresh food (as opposed to precooked), and to deliver it just in time when the food quality is at its maximum.

By way of comparison, *Hall et al* teaches a way to process orders from customers in a mobile environment while avoiding the problems traditionally associated with drive-through services. The system can receive an order from a mobile customer and determine the customer's location, a facility capable of completing the order, and an estimated time of arrival of the customer.

The customer can pay by credit or debit card, in which case a card on file is charged automatically, or can pay by smart card, in which case the card is swiped at the customer location on fulfillment. However, payment is handled through a mobile customer premises equipment (MCPE) 105, such as a cellular telephone or a PC. The MCPE 105 runs a personal agent system (PAS) 210, which is capable of communication with a financial system 158 over a connection 116 to handle payment.

As acknowledged in the Final Rejection, *Hall et al* does not teach the use of a wireless tag. Thus, the present claimed invention offers an advantage over *Hall et al* in terms of using something that many potential customers already have, namely, the wireless tag.

Kuykendall teaches a variety of payment techniques used at fast-food restaurants, including the use of toll-payment transponders. However, the techniques are limited to in-store use; there is no provision to receive information from mobile customers. It is not seen what *Kuykendall* adds to the hypothetical use of AVI discussed at the bottom of page 10 of the originally filed specification.

A person having ordinary skill in the art who had reviewed the applied references would not have been motivated to combine them as suggested in the Final Rejection. In terms of complexity, the applied references point in opposite directions. *Hall et al* requires the use of MCPE 105 capable of running a PAS 210 and connecting to a financial system 158. By contrast,

Kuykendall emphasizes the simplicity of paying with a toll transponder or keychain device. Therefore, a person having ordinary skill in the art would have concluded that combining the two references would have defeated the purpose of one or the other of them, with the result that the combination would not have been obvious, *Gore, supra*.

Further, since *Hall et al* teaches making payment through the PAS 210 running on the MCPE 105, the use of a transponder for payment would have been seen as superfluous and therefore non-obvious. The Final Rejection alleges that the use of a transponder “would increase the speed of delivery at the point of pickup.” However, it is not seen how that would be the case, since *Hall et al* teaches payment methods that would already be at least as fast as the use of the transponder of *Kuykendall*.

Moreover, even if the references had been combined as suggested in the Final Rejection, the combination would still not have resulted in the present claimed invention. In such a combination of references, the step or means for identifying a wireless tag identification number corresponding to the identification provided would have been absent, since neither of the applied references teaches or suggests any such thing. Instead, in such a combination, the wireless tag identification number would become relevant for the first time when the customer arrived to pick up the order. Since there would have been no previous verification of the wireless tag identification number, the merchant would run the risk that the customer would not have a transponder capable of paying. The present claimed invention, with the step or means for identifying, thus provides an advantage that the combination of references would not have taught or suggested.

The additional arguments against patentability set forth in the “Responses to Arguments” section of the Final Rejection will now be considered.

The Final Rejection, in the paragraph spanning pages 3 and 4, notes that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” The response is that the Appellant has not attempted to do so. The cases cited in the Final Rejection deal with situations in which an appellant answered a rejection over a combination of references by arguing against a single one of those references. By contrast, in the present application, the Appellant has stressed the combination of references, in terms of both whether it would have been obvious to make such a combination and whether such a combination would have resulted in the present claimed invention. However, the Appellant must necessarily include a discussion of each of the references individually, since the combination of references cannot be presumed, *Rouffet, supra*.

In the first full paragraph of page 4, the Final Rejection argues that the hypothetical use of AVI discussed in the originally filed specification cannot be read into the claims. Again, the Appellant has not attempted to do so. Instead, the Appellant has discussed that hypothetical use of AVI to show the state of the art and the ways in which the present claimed invention offers a non-obvious improvement over that state of the art.

In the paragraph spanning pages 4 and 5, the Final Rejection attempts to show that a person having ordinary skill in the art at the time the invention was made would have had the requisite motivation to combine the applied references because *Hall et al* recognizes the possibility that a customer may pay when the product or service is picked up. However, *Hall et al* must be read in its entirety, *Gore, supra*. *Hall et al* provides electronic techniques for advance payment and in fact places great emphasis on them. Thus, a person having ordinary skill in the art who had reviewed the applied references would have concluded that for a customer in a hurry, the preferred fast payment system in the system of *Hall et al* would be the one taught in

Hall et al. As a result, such a person would not have appreciated that a combination of *Hall et al* with *Kuykendall* would provide any advantage in speed over *Hall et al* by itself.

In that same paragraph, the Final Rejection attempts to describe a scenario in which the proposed combination of references would increase the speed of delivery at the pickup point. However, the scenario proposed in the Final Rejection rests on impermissible hindsight reconstruction of the invention, as it presupposes certain functionality that neither of the applied references teaches nor suggests.

Under that scenario as described in the Final Rejection, the customer would order hamburgers over the Internet or by wireless means. Then, as the customer approached the place of delivery, a wireless tag would notify the place of delivery that the customer had arrived.

However, that scenario suffers from the following fatal flaw. As noted above, neither of the applied references teaches nor suggests the step or means for identifying a wireless tag identification number corresponding to the identification provided, as recited in the present claimed invention. Thus, even if the fast-food establishment had a transponder reader, it would have no way to associate the order placed over the Internet or by wireless means with the wireless tag on the car that had just pulled up. As a consequence, in that scenario, the proposed combination, far from speeding up delivery, would be useless. The only teaching or suggestion to overcome that fatal flaw comes from the present claimed invention itself, with its step or means for identifying.

Finally, in the paragraph in the middle of page 5, the Final Rejection attempts to show that the applied prior art teaches the step or means for identifying by indicating that a Fastrak or Speedpass can uniquely identify a user and “activates wirelessly, payment for a product or service....” Even so, the applied references fail to teach or suggest identifying a wireless tag

identification number *corresponding to the identification provided* in placing an order. That is, when the order is placed, an identification is provided, and that identification is used to look up or identify the identification number of the wireless tag that will be used.

In the scenario proposed in the Final Rejection, that step or means would correspond to providing an identification number when placing the order, so that the fast-food restaurant would be able to look up the number of the wireless tag and know which car approaching the drive-up window corresponds to which order. However, in the references applied in the Final Rejection, such looking up quite simply does not take place. Accordingly, in the combination of references proposed in the Final Rejection, such looking up would be absent as well, and so would a key feature of the invention as defined by the claims on appeal. Again, the only teaching or suggestion to resolve such a deficiency comes from the present claimed invention itself.

For the reasons set forth above, the Appellant respectfully submits that the present claims define subject matter that would not have been obvious over the combination of references proposed in the Final Rejection. Therefore, the Appellant respectfully urges that the Final Rejection be reversed.

B. Claims 6 and 21

The Appellant believes that the arguments set forth above suffice to show the patentability of all of the claims. However, the Appellant respectfully submits that even if the rejection of claims 1-5, 8-15, 17-20, and 23-30 is upheld, claims 6 and 21 still define patentable subject matter.

Claim 6 adds the further limitation that providing an identification comprises providing a telephone number. Similarly, claim 21 adds the further limitation that the identification comprises a telephone number.

As an illustrative example, a customer placing an order at a fast-food restaurant would provide a telephone number in the course of placing the order. The telephone number would be used to look up the number of the customer's wireless tag. Thus, as the customer pulled into the fast-food restaurant, the customer's car would be identified.

The use of a telephone number imparts separate patentability. With regard to the claim limitations concerning identification of the wireless tag identification number, the Final Rejection reads those claim limitations on an operation of simply reading the tag. As explained above, the Appellant disputes that reading. However, even if that reading is accepted, there still remains a gap between the applied references and the present claimed invention in terms of providing a telephone number. Therefore, even if the reading of the claim limitations is accepted and the rejection of claims 1-5, 8-15, 17-20, and 23-30 is upheld, the Appellant respectfully submits that claims 6 and 21 are separately patentable and urges that the rejection of claims 6 and 21 be reversed.

C. Claims 7 and 22

The Appellant further submits that even if the rejection of claims 1-6, 8-21, and 23-31 is upheld, claims 7 and 22 still define patentable subject matter.

Claim 7 adds the further limitation that providing an identification comprises providing a personal identification number. Similarly, claim 22 adds the further limitation that the identification comprises a personal identification number.

As an illustrative example, a customer placing an order at a fast-food restaurant would provide a PIN in the course of placing the order. The PIN be used to look up the number of the customer's wireless tag. Thus, as the customer pulled into the fast-food restaurant, the customer's car would be identified.

The use of a PIN imparts separate patentability. With regard to the claim limitations concerning identification of the wireless tag identification number, the Final Rejection reads those claim limitations on an operation of simply reading the tag. As explained above, the Appellant disputes that reading. However, even if that reading is accepted, there still remains a gap between the applied references and the present claimed invention in terms of providing a personal identification number.

Moreover, the Appellant respectfully submits that the claims in groups B and C are separately patentable. The use of a telephone number may be preferable in certain situations; for example, where convenience is of paramount importance, the use of a telephone number gives customers one fewer thing to memorize. On the other hand, the use of a personal identification number may be preferable in certain other situations, by letting customers use secret identification rather than publicly accessible information such as telephone numbers. Neither is seen as merely an obvious variation of the other.

Therefore, even if the reading of the claim limitations is accepted and the rejection of claims 1-5, 8-15, 17-20, and 23-30 is upheld, and even if the rejection of claims 6 and 21 is also upheld, the Appellant respectfully submits that claims 7 and 22 are separately patentable and urges that the rejection of claims 7 and 22 be reversed.

D. Claims 16 and 31

The Appellant respectfully submits that even if the rejection of claims 1-15 and 17-30 is upheld, claims 16 and 30 still define patentable subject matter.

Claim 16 adds a further limitation directed to correlating the read tag identification number with a record of validated tags. Similarly, claim 31 adds a further limitation directed to means for correlating the read tag identification number with a record of validated tags.

The subject matter of claims 16 and 31 offers an advantage in ensuring that the merchant will be paid. For instance, if an order is placed with a fast-food restaurant, it can be verified in advance whether the customer's wireless tag will be usable to pay for the meal.

By contrast, in the combination of references proposed in the Final Rejection, no such correlation would take place. As a consequence, the fast-food restaurant would run the risk that the customer would not be able pay for the meal and that such inability to pay would not be knowable until after the meal had already been prepared.

Therefore, even if the rejection of all other claims is upheld, the Appellant respectfully urges that the rejection of claims 16 and 31 be reversed.

For all of the reasons set forth above, the Appellant respectfully urges reversal of the rejection of claims 1-31.

Respectfully submitted,

By: 

Michael C. Greenbaum

Reg. No. 28,419

BLANK ROME LLP
Watergate 600, 11th Floor
600 New Hampshire Ave., N.W.
Washington, D.C. 20037-2485
202-772-5836 direct dial
202-772-5800 receptionist
202-572-1436 direct facsimile
202-572-1400 general office facsimile

IX. Appendix: Claims on Appeal

1. An ordering method comprising:

placing an order for an item by specifying the item and a location for picking up the item,
and by providing an identification;

relaying the order to a validating processor;

identifying a wireless tag identification number corresponding to the identification
provided;

authorizing payment of the order from an account associated with the wireless tag; and

reading the tag identification number from the wireless tag when the tag is located in a
vicinity of the pick up location.

2. The method of claim 1, further comprising:

including the order in a list of orders sorted according to expected pick up time and item
preparation time.

3. The method of claim 2, further comprising:

displaying the list of orders in an area where the order is prepared before pick up.

4. The method of claim 1, further comprising:

identifying items prepared that correspond to the wireless tag.

5. The method of claim 1, wherein the step of placing an order further comprises:

providing an expected time for pick up.

6. The method of claim 1, wherein providing an identification comprises providing a
telephone number.

7. The method of claim 1, wherein providing an identification comprises providing a
personal identification number.

8. The method of claim 1, wherein the account is a pre-paid account containing a balance.
9. The method of claim 1, wherein the account is a credit card account.
10. The method of claim 1, wherein the account is a check card account.
11. The method of claim 1, wherein the step of relaying comprises relaying the order to the validating processor via Internet.
12. The method of claim 1, wherein the step of placing the order comprises placing said order over a telephone.
13. The method of claim 1, wherein the step of placing the order comprises placing said order via Internet.
14. The method of claim 4, further comprising:
displaying the identified items to a carrier of the tag.
15. The method of claim 1, further comprising:
authorizing payment of the order in the event that the account associated with the wireless tag has insufficient funds; and
charging at least the difference between the available funds in said account and a purchase price to a secondary account.
16. The method of claim 4, wherein the step of identifying items comprises correlating the read tag identification number with a record of validated tags.
17. An ordering system comprising:
means for placing an order for an item, the order including the item, a location for picking up the item, and an identification;
a communication channel for relaying the order to a validating processor;

means for identifying a wireless tag identification number corresponding to the identification provided;

means for authorizing payment of the order from an account associated with the wireless tag; and

means for reading the tag identification number from the wireless tag when the tag is located in a vicinity of the pick up location.

18. The system of claim 17, further comprising:

a unit for displaying a list of orders, including said order, sorted according to expected pick up time and item preparation time.

19. The system of claim 17, further comprising:

means for identifying prepared items that correspond to the wireless tag.

20. The system of claim 17, wherein the order further includes an expected time for pick up.

21. The system of claim 17, wherein the identification comprises a telephone number.

22. The system of claim 17, wherein the identification comprises a personal identification number.

23. The system of claim 17, wherein the account is a pre-paid account containing a balance.

24. The system of claim 17, wherein the account is a credit card account.

25. The system of claim 17, wherein the account is a check card account.

26. The system of claim 17, wherein the communication channel comprises the Internet.

27. The system of claim 17, wherein the means for placing the order comprises a telephone.

28. The system of claim 17, wherein the means for placing the order comprises a computer network.

29. The system of claim 19, further comprising:

an unit for displaying the identified items to a carrier of the tag.

30. The system of claim 17, further comprising:

means for authorizing payment of the order in the event that the account associated with the wireless tag has insufficient funds; and

means for charging at least the difference between the available funds in said account and a purchase price to a secondary account.

31. The system of claim 19, wherein the means for identifying items comprises means for correlating the read tag identification number with a record of validated tags.